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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,060	05/19/2000	Babu J. Mavunkel	21900-20290.00	1599

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MORRISON & FOERSTER LLP  
3811 VALLEY CENTRE DRIVE  
SUITE 500  
SAN DIEGO, CA 92130-2332

EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 11/29/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/575,060

Applicant(s)  
Mavenkel et al.

Examiner  
Celia Chang

Art Unit  
1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 9, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9, 11, 12, 16-37, 39-41, and 45-84 is/are pending in the application.
- 4a) Of the above, claim(s) 40 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 11, 12, 16-21, 29-33, 36, 37, and 39 is/are rejected.
- 7) ☒ Claim(s) 22-28, 34, 35, and 45-84 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### DETAILED ACTION

1. Amendment and response filed by applicants in Paper No.16, dated Sept. 9, 2002 have been entered and considered carefully. Claim 38 has been canceled. Claims 1-6, 9, 11-12, 16-37, 39, 45-84 are pending. Claims 40-41 remain withdrawn from consideration.

Please note that combination of two ingredients for the same purpose is considered prima facie obvious. Were applicants traverse on the ground that claims 40-41 are obvious variation of claims 1-6, 9, 11-12, 16-37, 39, 45-84, then there could have been no patentability of all the claims since combining two lipid lowering agents i.e. the compound of claim 1 as encompassed by JP 09124631 and corticosteroid (CA 127:79417) is considered prima facie obvious. In re Kerkhoven 205 USPQ 1069.

The requirement is still deemed proper and is therefore made FINAL.

2. The rejection of claim 1 under 35 USC 112 first paragraph as containing NEW MATTER is maintained for reason of record.

It has been clearly delineated that in the specification, the alkylene chain has been supported by page 5 to be  $n=0-3$ , thus, the now amended claim 1 wherein L1 and L2 are  $C_{1-4}$  alkylene or alkenylene is new matter. Applicants provided no evidence that such description contrary to the specification can be supported. It is noted that on pages 6-7 of the specification as pointed to by applicants founds ~~no~~ antecedent basis to "C1-C4 alkylene or alkenylene".

3. The objection of claims 61-84 is dropped in view of the amendments of claims 61-84.

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4. The rejection of claims 1-6, 9, 11-12, 16-21, 29-33, 36-37, 39 under 35 USC 103(a) over JP 09124631 in view of Patani is maintained for reason of record.

Applicants argued that JP 09124631 is believed to be resulted from misreading of the claims. Applicants argued that “there is no provision for L2 to a bond”. Please note that thought out the specification the variable “ $n$ ” has been defined to be 0-3. Therefore, the “C<sub>1-4</sub> alkylene or alkenylene” is NEW MATTER. After removing of new matter and the L2 as supported by the specification is an alkylene or (CH<sub>2</sub>) $n$ , and  $n$  is 0-3, the  $n=0$  will be a bond and reading on JP 09123631. Please note that by deleting the “R” to clarify the specification does not obviate the nature that the chain length was defined by the specification to be (CH<sub>2</sub>) $n$ , and  $n$  is 0-3.

5. Claims 22-28, 34-35, 45-84 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman, can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7922.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

*WP/Chang*

*Nov. 26, 2002*

  
*Celia Chang*

*Primary Examiner*

*Art Unit 1625*